

DOCKET NO: 264178US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

:

HIROYUKI NAITOU, ET AL.

: EXAMINER: HAILEY, P. L.

SERIAL NO: 10/519,407

:

FILED: JANUARY 5, 2005

: GROUP ART UNIT: 1755

FOR: PROCESS FOR PRODUCING  
CATALYSTS FOR THE PRODUCTION  
OF METHACRYLIC ACID

:

REPLY BRIEF

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

The following Reply Brief is in reply to the Examiner's Answer dated August 22, 2007 (Answer).

Applicants acknowledge that the Examiner has withdrawn the rejection over US 6,458,740 (Kasuga et al) (Answer at 4). In addition, the Examiner's statement of the remaining rejection over JP 2000-296336 A (Naito et al) (Answer at 3-4) is verbatim with the final rejection and has been responded to in the Appeal Brief. Thus, the remainder of this Reply Brief is in reply to the Response to Argument (Answer at 4-5).

In response to Applicants' argument in the Appeal Brief that Naito et al did not, in effect, consider addition times, the Examiner notes the comparative data of record and then states:

However, although Example 8 of Naito et al. and Appellants' Comparative Example 4 exhibit the same values for methacrolein conversion, methacrylic acid selectivity, and methacrylic acid yield, one of ordinary skill in the art would not

be *immediately* led to the conclusion that a mixing time of 30 minutes - as shown in Appellants' Comparative Example 4 - is the reason said values were obtained in Example 8 of Naito et al. The Examiner also notes that, in both the inventive Example 11 and Comparative Example 4, the mixing times of both liquids B and C are changed; Appellants' claimed invention, in its broadest interpretation, hinges in criticality only on the mixing time of liquid B. Therefore, Appellants' comparisons do not appear to be commensurate in scope with the claims under appeal, in their present form.

(Answer at 4-5).

In reply, and as alluded to at page 8 of the Appeal Brief, the translation of Example 8 and Table 1 of Naito et al were made of record to show that the mixing time for liquid B therein was 30 minutes. The purpose was **not to demonstrate** that all other variables being the same, the mixing time for liquid B is critical, although it is Applicants' position that they have discovered that the mixing time for liquid B is a result-effective variable. Indeed, as already pointed out in the Appeal Brief, Naito et al does not present a *prima facie* case of obviousness, so there is no necessity for Applicants to demonstrate any criticality. Nevertheless, other examples and comparative examples in the specification herein **do** demonstrate the effect when all variables are maintained constant except for the mixing time for liquid B. Thus, Examples 1-3 and 5, and Comparative Examples 1 and 2, differ only in the mixing time for liquid B. As Table 1 of the specification shows, the yield of methacrylic acid for the examples ranged from 71.5 to 72.4%, while the corresponding yield for the comparative examples ranged from 68.7 to 69.4%.

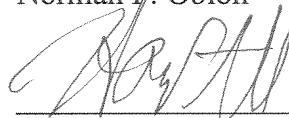
Finally, the many arguments in the Appeal Brief that have not been addressed, let alone rebutted, by the Examiner must be deemed to be admitted.

For all the above reasons, Applicants continue to maintain that the rejection over  
Naito et al should be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

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